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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,260	03/31/2004	Paul A. Thomas	05997.0013-0300	5447
22852	7590	02/12/2009	EXAMINER	
		FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413	NORMAN, SAMICAL	
			ART UNIT	PAPER NUMBER
			3696	
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			02/12/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/813,260	THOMAS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	SAMICA L. NORMAN	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 December 2008.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15,28 and 29 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15,28 and 29 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081209</u> .                                                | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

1. **Claims 1-15, 28 and 29 are pending. Claims 16-27 and 30-33 are cancelled.**

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-5 and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-5 and 28 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-9, 11-14, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould et al., U.S. Patent No. 5,966,700 (reference A on the attached PTO-892) in view of Cassidy et al., U.A. Patent No. 7,099,843 (reference B on the attached PTO-892).

7. As per claims 1, 6 and 11, Gould et al. teaches a method for reducing capital required to be held in connection with a subject pool of loans comprising: obtaining a credit risk rating of the loans in the subject pool (see column 6, lines 44-47); allocating credit risk for the subject pool among a plurality of parties, based on the credit risk rating and a loss performance of the subject pool (see column 3, lines 30-34 and column 5, lines 51-54), applying capital reserve requirements to the subject pool based on the credit risk rating and the credit risk allocated to a party subject to the capital reserve requirements for loans in the subject pool (see column 3, lines 40-44); and holding an amount of capital against the subject pool based on application of the capital reserve requirements (see column 3, lines 57-61). Gould et al. does not explicitly teach a comparison being made to a reference pool of loans having similar characteristics to the loans in the subject pool. Cassidy et al. teaches a comparison being made to a reference pool of loans having similar characteristics to the loans in the subject pool (see column 3, lines 11-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate this feature into the method of Gould et al. One of ordinary skill in the art would have recognized that applying the technique of Cassidy et al. would have yielded predictable results.

8. As per claims 2, 7 and 12, Gould et al. in view of Cassidy et al. teaches the method of claim 1 as described above. Gould et al. further teaches wherein allocating credit risk for the subject pool further comprises: for the party subject to the capital reserve requirements from the plurality of parties, capping a portion of the credit risk allocated to the party at a maximum level (see column 4, lines 14-17).

9. As per claims 3, 8 and 13, Gould et al .in view of Cassidy et al. teaches the method of claim 2 as described above. Gould et al. further teaches wherein the maximum level is a percentage of the subject pool value (see column 3, lines 66-67 and column 4, lines 1-2).

10. As per claims 4, 9 and 14, Gould et al. in view of Cassidy et al. teaches the method of claim 1 as described above. Gould et al. further teaches wherein allocating credit risk for the subject pool comprises: assigning a portion of the credit risk for the subject pool to the party subject to the capital reserve requirements; and assigning a remaining portion of the credit risk to a second party (see column 5, lines 61-63).

11. As per claims 28 and 29, Gould et al. teaches a method for reducing capital required to be held in connection with a subject pool of assets comprising: obtaining a risk rating of the assets in the subject pool (see column 6, lines 44-47); retaining, by a party subject to capital reserve requirements for loans in the subject pool among a plurality of parties, a portion of risk for the subject pool, based on the risk rating and a loss performance of the subject pool (see column 3, lines 40-44); applying the capital reserve requirements to the subject pool based on the risk

rating and the portion of risk retained by the party subject to the capital reserve requirements for loans in the subject pool (see column 3, lines 40-44); determining an amount of capital to hold in reserve in connection with the subject pool based on application of the capital reserve requirements (see column 3, lines 57-61); and presenting the determined amount of capital (see Abstract, lines 16-20). Gould et al. does not explicitly teach a comparison being made to a reference pool of loans having similar characteristics to the loans in the subject pool. Cassidy et al. teaches a comparison being made to a reference pool of loans having similar characteristics to the loans in the subject pool (see column 3, lines 11-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Gould et al. One of ordinary skill in the art would have recognized that applying the technique of Cassidy et al. would have yielded predictable results.

12. Claims 5, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould et al., U.S. Patent No. 5,966,700 (reference A on the attached PTO-892) in view of Cassidy et al., U.A. Patent No. 7,099,843 (reference B on the attached PTO-892) and further in view of Seiberg, “Risk-Indexed Capital Rules Proposed by Global Panel” (reference V on the attached PTO-892).

13. As per claims 5 and 10, Gould et al. in view of Cassidy et al. teaches the method of claim 4 as described above. Gould et al. does not explicitly teach wherein the credit risk rating includes a plurality of rating categories, and wherein assigning a portion of the credit risk for the

subject pool further comprises: retaining a portion of credit risk on a category by category basis for each of a plurality of rating categories; and capping the portion of retained credit risk to a maximum level for each of the plurality of rating categories. Seiberg teaches wherein the credit risk rating includes a plurality of rating categories, and wherein assigning a portion of the credit risk for the subject pool further comprises: retaining a portion of credit risk on a category by category basis for each of a plurality of rating categories; and capping the portion of retained credit risk to a maximum level for each of the plurality of rating categories (see page 2, paragraph 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method of Gould et al. One of ordinary skill in the art would have recognized that applying the technique of Seiberg would have yielded predictable results.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 1-15, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMICA L. NORMAN whose telephone number is (571)270-1371. The examiner can normally be reached on Mon-Thur 6:30a-5p, w/ Fri off.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

sln